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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,869	01/24/2002	Hiroshi Nagasawa	NAGASAWA=7	5352

1444 7590 02/02/2006

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/053,869

Applicant(s)

NAGASAWA, HIROSHI

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 23 January 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 6-13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

BJ Forman
Primary Examiner
Art Unit: 1634

Continuation of 3. NOTE:

The claims have been amended to further define the substrate as "flexible" and to limit the carrier to "a porous glass powder" sandwiched between "polyethylene or polyester films". In papers filed 29 April 2005, Applicant asserted that the cited art did not teach flexible substrates. Because the claims were not limited to "flexible" substrate, the Office responded by stating that the assertion was not commensurate in scope with the claims. The Office further stated that even if the claims were limited to flexible substrate, they would not be free of the cited art because flexibility is a relative term, such that any substrate material would be considered flexible when compared to some other less flexible substrate. Therefore, the substrate of Stein is flexible in comparison to some other less flexible substrate. Furthermore, Stein teaches a substrate is made of any glass or plastic e.g. polyethylene (page 18, lines 5-18, as cited in the final office action). Applicant has not provided any evidence demonstrating that the substrate of Stein is not flexible. Therefore, the amendment to Claim 6 does not place the claims in better form for appeal.

The amendment to Claim 7 limits the carrier to porous glass powder further limiting new Claim 14, which defines the particle size of the powder. As cited in the final office action, Stein teaches porous glass powder (fig. 10 and pages 23-25). However, the particle size of the glass powder was not previously considered. Therefore, new Claim 14 would require further search and consideration.

The amendment to Claim 12 further limits the plastic film to polyethylene or polyester. Stein teaches stacked polyethylene substrates having filters in the through holes as claimed (e.g. page 18 and fig. 7-11).

Applicant asserts that the claimed invention is different from that of Stein. Applicant states that the object of the instant invention is that the user can peel or separate the stacked chips to place them in contact with the sample. Applicant's comment is noted, however, the intended use of the device as described in the specification (or arguments) does not define the device over the prior art. Applicant further states that the preferred embodiment utilizes a substrate having the dimension of 50 x 30 x 0.3 mm-having through holes of 2mm-diameter. The embodiment is noted, however, the claimed device is not limited the preferred embodiment having these dimensions. Therefore, the argument is not commensurate in scope with the claims.

Applicant asserts that Stein does not teach porous glass having the claimed pore size. The assertion is noted, however the previously examined claims were not limited to the pore size of porous glass. Therefore the argument does not address the rejected claims. Furthermore, amended Claim 7 does not define pore size as asserted by Applicant. Therefore, the argument is not commensurate in scope with the rejected or amended claims.

Applicant asserts that the heat-sealing as recited in Claims 12-13 differs from the sealed substrates of Stein. The argument has been considered but is not found persuasive because Applicant has not provided any factual evidence of the asserted difference. Therefore, the argument is deemed unsupported arguments of counsel.


BJ FORMAN, PH.D.
PRIMARY EXAMINER